

REMARKS

The present application has been amended in response to the Examiner's Office Action to place the application in condition for allowance. Applicant, by the amendments presented above, has made a concerted effort to present claims which clearly define over the prior art of record, and thus to place this case in condition for allowance.

In the Office Action, the Examiner rejected claims 1-4 and 6-7 under 35 U.S.C. §103(a) based on a combination of Drill et al. (U.S. Patent No. 6,347,979) and Tanaka (U.S. Patent No. 5,902,173). In making the rejection, the Examiner pointed out that "Drill does not disclose at least one channel located inside the wear ring in communication with the plurality of outlets." However, the Examiner also pointed out that Drill suggests providing a "manifold", and asserted that Tanaka "teaches that it is well known to have utilized at least one channel S in communication with a number of holes R so that polishing agent P can be supplied therefore from a dispensing nozzle 49 to the wafer 45 via the groove S and holes R."

Applicant respectfully submits that Tanaka does not disclose or suggest providing a channel inside the wear ring, but rather merely discloses a channel on the top surface of the wear ring. Additionally, while Drill mentions providing a "manifold", Drill does not specify the exact structure claimed (i.e., a peripheral channel which is located inside the wear ring). Obviously, the "manifold" could be provided as a channel on the top surface of the wear ring, like Tanaka, and still be considered a "manifold" so long as it communicated with a plurality of outlets.

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Applicant submits that merely because Drill et al. mentions the possibility of providing a "Manifold" and Tanaka discloses providing a channel on the top surface of the wear ring, a combination of Drill et al. and Tanaka does not provide the claimed invention, and to assert that it does amounts to hindsight.

There are many court decisions which hold that using hindsight is improper. As early as 1891, the United States Supreme Court held that:

Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention. But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not. It regards a change as evidence of novelty, the acceptance and utility of change as further evidence, even as demonstration . . . Nor does it detract from its merit that it is the result of experiment and not the instant and perfect product of inventive power. A patentee may be baldly empirical, seeing nothing beyond his experiments and the result; yet if he has added a new and valuable article to the world's utilities, he is entitled to the rank and protection of an inventor . . . It is certainly not necessary that he understand or be able to state the scientific principles underlying his invention, and it is immaterial whether he can stand a successful examination as to the speculative ideas involved.

Diamond Rubber Co. v. Consolidated Rubber Tile Co., 220 U.S. 428 , 435-36.

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Nevertheless, the independent claims have been amended to further distinguish the claimed invention from that which is disclosed in Drill et al. and Tanaka. Specifically, claims 1 and 15 have been amended to specifically claim that all of the outlets are in communication with the peripheral channel which is inside the wear ring, and that the slurry exits all of the channels. This is in contrast to Drill et al. and Tanaka. While Drill et al. mentions providing a "manifold", Drill et al. mentions as such in connection with "asymmetric slurry injection" wherein slurry is only provided to selected outlets and not to all of them (see col. 8, lines 36-67 (and specifically lines 40-42, 53-43, 61-63)). Applicant respectfully submits that not only does Drill et al. fail to disclose providing that all of the outlets are in communication with a peripheral channel which is inside the wear ring, and that the slurry exits all of the channels, but that Drill et al. teaches away from providing as such, when discussing using a "manifold" to facilitate "asymmetric slurry injection".

A basic tenet of U.S. patent law is that "an invention that otherwise might be viewed as an obvious modification of the prior art will not be deemed obvious in a patent law sense when one or more prior art references "teach away" from the invention." *Chisum on Patents*, § 5.03[3], at 5-135 (2000). See, for example, Gillette Co. v. S.C. Johnson & Sons, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990) (stating that the closest prior art reference "would likely discourage the art worker from attempting the substitution suggested by the [inventor/patentee]"); American Standard Inc. v. Pfizer Inc., 14 USPQ2d 1673, 1707 (D. Del. 1989) (stating that "[a]lthough each reference used in an obviousness inquiry does not have to be enabling . . . disclosures in the references that 'teach away' from the claimed invention cannot be disregarded"); Phillips Petroleum Co. v. U.S. Steel Corp., 6 USPQ2d 1065, 1093 (D. Del. 1987),

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aff'd, 9 USPQ2d 1461 (Fed. Cir. 1989) (holding that "the prior art references relied upon must be considered in their entirety . . . Disclosures in the references that diverge from and teach away from the invention cannot be disregarded"); Dow Chemical Co. v. United States, 18 USPQ2d 1657, 1662 (Cl. Ct. 1990) (stating "this is a classic case of 'teaching away' from the invention").

Additionally, Tanaka does not disclose providing that all of the outlets are in communication with a peripheral channel which is inside the wear ring, and that the slurry exits all of the channels. Instead, as discussed above, Tanaka discloses a channel which is provided on the top surface, as opposed to inside, a wear ring.

Applicant respectfully submits that neither Drill et al. nor Tanaka, nor a combination of these two references, discloses or suggests what is now being specifically claimed. As such, Applicant respectfully requests that the present application be passed to issue.

Should the present claims not be deemed adequate to effectively define the patentable subject matter, the Examiner is respectfully urged to call the undersigned attorney of record to discuss the claims in an effort to reach an agreement toward allowance of the present application.

Respectfully submitted,

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